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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,299	01/30/2002	Thomas Newmark	9510.101F	7346

7590 03/22/2004

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EXAMINER	
WINSTON, RANDALL O	

ART UNIT	PAPER NUMBER
1654	

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/058,299	NEWMARK ET AL.	
	Examiner	Art Unit	
	Randall Winston	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *18 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) *13-24* is/are withdrawn from consideration.

5)☐ Claim(s) *8-12* is/are allowed.

6)☐ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/18/2003 has been entered.

Claims 1-24 are pending. However, as previously set forth in the Non-final office action of 1/08/2003, Applicant's election without traverse of the invention of Group I, claims 1-12 submitted 10/23/2002 will be examined again on the merits. The amended of claims 1, 3, 5 and 6 submitted on 4/8/2003 will be examined within the original claims submitted on 10/23/2002.

Claims 13-24 drawn to a method remains withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U..S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 5 are rendered vague and indefinite because they fail to recite any operative amount of the claimed extracts. Therefore, it is unclear if the extract(s) is/are the active agent(s) within the composition, if they are merely some type of inert agent(s), and/or if one or both are present in very small amounts representing perhaps a contaminant or residue. The claimed turmeric extracts are each deemed to be essential elements of the invention and, as such, it should be clearly defined (functionally) in the claim language itself. Accordingly, it is strongly suggested that claim 3 be appropriately incorporated into claim 1 to clarify this ambiguity.

All other claims depend directly or indirectly from the rejected claims and are, therefore, also rejected under 35 U.S.C. 112, second paragraph for the reasons set forth above.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,264,995.

Although the conflicting claims are not identical, they are not patentably distinct from each other because in both cases, the claims are drawn to a composition comprising a hydroalcoholic and supercritical carbon dioxide extract of turmeric, as well as other claimed herbal ingredients. Further, the instantly claimed invention encompasses the claimed invention of 6,264,995.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chassangnez-Mendez et al., *A mass transfer model applied to the supercritical extraction with C02 of curcumins from turmeric rhizomes(Curcuma longa)*, Brazilian Journal of Chemical Engineering 17(3), 315-322, 2000, abstract, in view of Woznicki et al. (US 4,475,919) and Takagaki (JP4041221164A, abstract)

Applicant claims a composition comprising of effective amounts of a supercritical extract of turmeric, hydroalcoholic extract of turmeric, and an aqueous extract of green tea.

Please note, the intended use of the above claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In

the instant case, the intended use does not create a structural difference, thus the intended use is not limiting (see, e.g., MPEP 2112).

Chassangnez-Mendez et al. teach (see, e.g., abstract) that the active ingredients of a supercritical extract of turmeric are used in the food industry for food coloring. Chassangez-Mendez et al. do not teach that the active ingredients of a hydroalcoholic extract of turmeric and the active ingredients of an aqueous extract of green teach can also be used in the food industry for food coloring.

Woznicki et al. beneficially teach (see, e.g., title, abstract, example II) that turmeric is dissolved in ethyl alcohol to produce a dye that can be used in the food industry for food coloring. (please note that it is known to one of ordinary skill in the art the ethyl alcohol is diluted with water, thus, ethyl alcohol is hydroalcoholic).

Takagaki benefically teach (see, e.g. abstract, title) that extracting green tea with an organic solvent such as water to produce active ingredients that can be used in the food industry for preventing the fading of food and/or food coloring.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Chassangnez-Mendez's teachings to include the beneficial teachings of Woznicki et al. and Takagaki because the three combined teachings would create an improved composition that can be used in the food industry for food coloring and/or preventing the fading of food. The adjustment of other conventional working conditions (e.g., orally administering the composition and the active ingredients' amounts/ranges), are deemed a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Accordingly, the invention as a whole is prima facie obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter: Claims 8-12 instantly claimed composition is neither taught nor reasonably suggested by the prior art of record. There is no motivation in the cited prior art to combine the instantly claimed ingredients within the amounts/ranges instantly claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Winston whose telephone number is 571-272-0972. The examiner can normally be reached on 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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CHRISTOPHER R. TATE
PRIMARY EXAMINER